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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/621,946

Applicant(s)

DILIP ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 11-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to Applicants communication dated July 1, 2003. Original claims 1-51 are pending. Applicants' provisional election made without traverse to prosecute invention I comprising claims 1-10 has been noted. Cancellation of claims 11-51 by the Applicants has been noted. Claims 11-51 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 1-10 have been examined. The rejections are stated below.

Claim Rejections - 35 USC § 101

2. Claims 1-9 of the invention are directed to non-statutory subject matter. Claims 1-9 are drawn to a method for analyzing a plurality of asset accounts having a common account holder, identifying an attribute associated with each of the plurality of asset accounts and determining whether an adjustment of assets among the plurality of asset accounts would benefit the account holder that is not tied to any technological art. The claimed invention is directed merely to human making mental computations and manually plotting results on paper, and thus is nothing more than an abstract idea, which is not tied to any technological art, and is not a useful art as contemplated by the constitution. The abstract idea does not become a technological art merely by the recitation in the claim of "transforming physical media into a chart" and "physically plotting a point on said chart". (See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished))

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US Patent 6,018,722)

With reference to claim 1, Ray teaches a method comprising analyzing a plurality of asset accounts having a common account holder, identifying an attribute associated with each of the plurality of asset accounts and determining whether an adjustment of assets among the plurality of asset accounts would benefit the account holder. (See Ray claims 2-4) The securities in the account holder's portfolio are the asset accounts, the attribute associated with the asset accounts is the risk/return ratio and adjustments to the asset allocation include adjustments of assets. When the risks of assets are the same, the defining attribute becomes the return on the asset accounts.

With reference to claims 2-5, Ray teaches the steps wherein the attribute is an interest rate (See Ray Column 2 lines 16-19), identifying best available market interest rates for similar asset accounts (inherent in Ray claims 3-4 because returns for fixed income accounts are the interest rates), identifying a best interest rate among the plurality of asset accounts (inherent in Ray claims 3-4) and recommending opening a new asset account if available market interest rates for similar asset accounts are better than at least one of the plurality of asset accounts (inherent in Ray claims 3-4). The step of opening a new asset account is the same as buying a security not included in the current portfolio.

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With reference to claims 7-10, Ray also teaches recommending adjustment of assets among the plurality of asset accounts if such an adjustment would increase the interest earned by the account holder; and offering to perform the recommended adjustment of assets (See Ray claim 5) and one or more computer-readable memories containing a computer program that is executable by a processor to perform the method recited in claim 1 (inherent in the computer system disclosed by Ray figure 2 and accompanying description)

With reference to claim 6, Ray teaches a method of claim of claim 1 as discussed above.

Ray does not explicitly teach the step wherein each asset is associated with a different financial institution.

Official notice is taken that the step of associating each asset with a separate financial institution is old and well known in the art. By investing in assets of different financial institutions the account holder achieves diversification and may be able to maximize his/her return on the total holdings.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the step of associating each asset with a separate financial institution to the invention of Ray. The combination of the disclosures taken as a whole suggests that account holders would have benefited from the diversification and the chance to maximize the total returns of their holdings.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to

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7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
July 10, 2003

Richard Weisberger
Primary Examiner